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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/805,196	03/14/2001	Christopher Paul Kenneth Smithies	111828.120US1	1727
28089	7590	12/01/2005	EXAMINER	
WILMER CUTLER PICKERING HALE AND DORR LLP			VIG, NARESH	
399 PARK AVENUE			ART UNIT	
NEW YORK, NY 10022			PAPER NUMBER	

3629

DATE MAILED: 12/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/805,196	SMITHIES ET AL.	
	Examiner	Art Unit	
	Naresh Vig	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-29 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1 – 10, 21 and 27 drawn to recording evidence of consent by a voice recording system to a transaction involving a relying party and an affirming party, by providing a transaction identifier corresponding to the transaction, to the relying party which is transmitted by the relying party to the affirming party, after establishing electronic communications between the affirming party and the voice recording system, affirming party provides the transaction identifier to the voice recording system, a voice message indicating that the affirming party assents to the transaction; recording and storing the voice message at the voice recording system, the voice recording system generates a recording identifier associated with the recorded voice message, and communicates the recording identifier to the relying party, classified in class 705, subclass 1.
- II. Claims 11 – 16, 22 – 23 and 28 – 29 drawn to recording consent to a transaction using a voice recording system, the transaction involving a relying party and an affirming party by receiving a transaction identifier at the voice recording system, recording a voice message received from the affirming party, storing the voice message in the voice recording system; and associating a recording identifier

with the recorded voice message, voice recording system provides the recording identifier to the relying party and the affirming party and notifying the relying party that the voice message has been stored, classified in class 705, subclass 1.

III. Claims 17 and 18, drawn to obtaining evidence of consent to a transaction involving a relying party and an affirming party where the relying party associates a transaction identifier with the transaction, provides the transaction identifier to the affirming party; the relying party receiving a recording identifier from a voice storage system, receipt of the recording identifier indicating that the affirming party assented to the transaction by providing a voice message that has been recorded by the voice storage system, the recording identifier associated with the recorded voice message, wherein relying party receives the transaction identifier from the voice storage system, and the relying party associates transaction identifier with a transaction, classified in class 705, subclass 1.

IV. Claims 19 and 20, drawn to method for gathering evidence of assent to a proposition, by assigning an identifier to the proposition, the identifier associating a party with the proposition, communicating the identifier to the party to enable the party to record a spoken declaration of assent to the proposition; and upon making the recorded spoken declaration, receiving notification that the recording has been completed wherein the recording is initiated by receipt of the identifier by a recording system from the party, classified in class 705, subclass 1.

- V. Claims 24 – 26, drawn to entering into a contract by a party receiving a contract and instructions how to signify agreement to the contract, including instructions as to how to establish communications with a recording system, establishing communications between the party to the contract and the recording system; communicating a transaction identifier to the recording system; communicating a spoken declaration to indicate assent to the contract after receiving a prompt from the recording system, providing the recording identifier to the party to the contract received from the recording system, classified in class 705, subclass 1..

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II – V are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because in invention I relying party is provided a transaction identifier corresponding to the transaction, voice recording system, relying party providing the received transaction identifier to the affirming party, voice recording system generates a recording identifier associated with the recorded voice message, and communicates the recording identifier to the relying party.

Inventions II and I & III – V are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because in invention II relying party is not provided a transaction identifier corresponding to the transaction which is provided by the relying party to the affirming party, but both relying party and affirming party receive the transaction identifier at the voice recording system, voice recording system notifies the relying party that the voice message has been stored.

Inventions III and I – II & IV – V are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because in invention III relying party receives the transaction identifier from the voice storage system, and associates transaction identifier with a transaction for recording the assent to the transaction.

Inventions IV and I – III & V are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because in invention IV gathers evidence of assent to a proposition, by assigning an identifier to the proposition, communicating the identifier to the party to enable the party to record a spoken declaration of assent to the proposition, recording is initiated by receipt of the identifier by a recording system from the party, receiving notification that the recording has been completed wherein the

Inventions V and I – IV are related as combination and subcombination.

Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because in invention V a party receiving a contract and instructions on how to signify agreement to the contract, including instructions as to how to establish communications with a recording system, establishing communications between the party to the contract and the recording system, communicating a transaction identifier to the recording system,

providing the recording identifier to the party to the contract received from the recording system.

Because these inventions are distinct for the reasons given above and the search required for one Group is not required for other Groups, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

This application contains claims directed to the following patentably distinct species of the claimed invention:

Claims 3, 5 is performed over a telephone network, whereas, Claim 4, 6 is performed over a computer network; Claim 7, 10 is performed using electronic messaging, and, Claim 9 is performed using paper document.

Claim 12, directed to transaction identifier is received during establishment of communications between the affirming party and the recording system, whereas, Claim 13, directed to transaction identifier is received after establishment of communications between the affirming party and the recording system.

Claim 14, is directed to providing of recording identifier to the relying party, whereas, claim 15 is directed to providing the recording identifier to the affirming party.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naresh Vig whose telephone number is (571) 272-6810. The examiner can normally be reached on M-F 7:30 - 6:00 (Wednesday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Naresh Vig
Examiner
Art Unit 3629

November 28, 2005